

REMARKS

Claims 1-11 are presented for examination in the instant application. In the parent application, Serial No. 09/543,693, filed 05 April 2000, specifically in the Office Action mailed 06 November 2001 therein, Claims 21 and 26-32 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Pat. No. 4,733,520 to Rabbi (hereinafter, "Rabbi") in view of U.S. Pat. No. 5,526,917 to Homma (hereinafter, "Homma"). Applicant respectfully submits that the present claims are distinguished over the Prior art, for at least the reasons set forth below.

Claim 1 recites a device for singulating surgical needles from a bulk supply of needles comprising, *inter alia*, a discharge device having first and second needle receiving pockets. Claim 1 further recites a control means singulating individual needles into said first and second needle receiving pockets. The Office Action cited above avers that these features are present in Rabbi. Applicant respectfully disagrees.

In contrast to the present invention, Rabbi teaches a device for supplying tablets to be packaged in blister packs. What the Office Action cites as a discharge device having needle-receiving pockets (Rabbi Fig. 2, reference 10) is in fact a multiple channel device, having a plurality of tracks, but no pockets. Further, the Office Action attributes an unshown control means to Rabbi. Such a presumption may or may not be true, as the text of Rabbi contains no mention of any control system. However, the nature of Rabbi's vibratory device is that it may operate continuously without a control means as recited in the instant invention. Rabbi does not teach or suggest any control means or other means of singulating the dispensed items into the channels. As seen in Fig. 3 of Rabbi, the

tablets are continuously and multiply fed into those channels, and are only singulated at the bottom of the channels by insertion into the blisters (5).

Homma does not offer, nor is alleged to offer, any teaching or suggestion to ameliorate the above-noted deficiencies of Rabbi relative to the claims. It has been held by the courts that in order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *See, In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Therefore, Applicant respectfully submits that Claim 1 is patentably distinguished over the prior art, taken alone or in any combination. Claims 2-10 depend either directly or indirectly from claim 1. They are each separately patentable, as discussed in part below, but are submitted as patentable for at least the same reasons as independent claim 1.

With respect to claims 2-4, the Office action avers that Rabbi teaches an adjustable dam, embodied in guide means 16 (Fig. 2), to remove overlapping and/or nested needles. Initially, Rabbi has no teaching or suggestion that the guide means are adjustable. Further, the disclosure of Rabbi has no teaching or suggestion of application to objects capable of nesting, such as surgical needles, only cylindrical tablets. Therefore, the application of Rabbi to the nesting feature is untenable conjecture. “[The Board] may not... resort to speculation, unfounded assumptions, or hindsight reconstruction to support deficiencies in its factual basis.” *In re GPAC, Inc.*, 57 F.3d 1573, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995). Moreover, the adjustable dam recited in the claims is structurally distinct from the cited guides. Therefore, even assuming, *arguendo*, that the guides and the dam perform a similar function of removing overlapping objects, Rabbi does not anticipate this feature because of the structural

differences. *See, In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) (where structural features are absent in a prior art reference, the ability of the features present in the reference to perform the function of the absent structure does not negate patentability); See also, M.P.E.P., 8th Ed., Rev. 1, § 2114 (Feb. 2003). Applicant respectfully submits that claims 2-4 are further distinguished over the prior art.

With respect to claims 5-8, the only indication in the Office Action that Rabbi teaches the claimed features of the control means is a summary reference to an unshown control means. Examination of the text of Rabbi uncovers no mention of any control system, nor what is controlled in what ways. Turning to the proposed combination with Homma, Homma teaches the use of proximity sensors, not optical sensors. Regarding the control signals produced by Homma's proximity sensors, the sensors merely counting the quantity of passing electronic components, and activate a second vibratory hopper (6) to maintain the supply of parts in a feeder bowl (1). Moreover, Homma has no teaching or suggestion of any control signals as recited in claims 6-8.

In light of the foregoing, Applicant respectfully submits that all claims recite patentable subject matter, and kindly solicit an early indication of allowability. If the Examiner has any reservation in allowing the claims, and believes that a telephone interview would advance prosecution, he is invited to telephone the undersigned at his earliest convenience.

Respectfully Submitted



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